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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,549	05/13/2004	Tien-Hui Pan	ACMP0195USA	3548

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NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

YOUSEFI, SHAHROUZ

ART UNIT	PAPER NUMBER
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2132

NOTIFICATION DATE	DELIVERY MODE
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09/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

winstonhsu.uspto@gmail.com
Patent.admin.uspto.Rcv@naipo.com
mis.ap.uspto@naipo.com.tw

Office Action Summary	Application No. 10/709,549	Applicant(s) PAN, TIEN-HUI	
	Examiner SHAHROUZ YOUSEFI	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Best (US 4,278,837).

3. With respect to claim 1, Best discloses a method of preventing firmware from being pirated (*A microprocessor for executing computer programs which are stored in cipher to prevent software piracy, abstract*), the firmware containing executable code for an electronic device, the method comprising: ciphering executable firmware code into ciphered firmware code (*enciphering each program in a different cipher, col. 2, lines 44-45*); storing the ciphered firmware code in a nonvolatile memory of the electronic device (*storing the enciphered program into memory 12, col. 14, line 17*); storing a decipher key in a decrypting circuit of the electronic device (*cipher key or tables for deciphering the program, so that a program that can be executed, abstract*); deciphering the ciphered firmware code with the decrypting circuit of the electronic device to decrypt the executable firmware code (*deciphering circuit, element 4, fig. 6*); storing the executable firmware code in a volatile memory of the electronic device (*storing said program in a memory, col. 31, line 28*); and executing the executable firmware code stored in the

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volatile memory for operating the electronic device (*a microprocessor for executing computer programs which are stored in cipher, abstract*).

4. With respect to claim 2, Best discloses software installed on a host computer ciphers the executable firmware code into the ciphered firmware code (In this system programs are stored in a conventional host computer in encrypted form, col. 2, lines 9-11).

5. With respect to claim 3, Best discloses the software installed on the host computer transmits the ciphered firmware code to a firmware refresh circuit of the electronic device and the firmware refresh circuit stores the ciphered firmware code in the nonvolatile memory of the electronic device (A typical CMP is schematically shown as box 16 in FIG. 3. CMP 16 executes the enciphered program in memory 12 by addressing program portions, col. 4, lines 46-49).

6. With respect to claim 4, Best discloses the software installed on the host computer transmits the ciphered firmware code to a firmware burner, the firmware burner is connected to the electronic device, and the firmware burner stores the ciphered firmware code in the nonvolatile memory of the electronic device (Plain unenciphered data may be read and written in the conventional manner via buses 14 and 61 and buffer 60...Ram 75 or output on bus 14, col. 9, lines 24-29).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Best (US 4,278,837) in view of Satkunanathan et al. (US 2005/0114265) hereinafter Satkunanathan.

9. With respect to claim 5, Best doesn't teach the nonvolatile memory is a flash memory. However, Satkunanathan discloses a multitude of storage mediums including but not limited to a magnetic storage devices (e.g., computer hard drive, floppy disk), optical storage devices (e.g., CD-RW disk), and flash memory devices (e.g., memory stick, memory card), par. [0050]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Best with flash memory of Satkunanathan to include and support more variety of storage medium.

10. With respect to claim 6, Satkunanathan teaches that nonvolatile memory is dynamic random access memory (DRAM) (dynamic RAM (DRAM), par. [0091]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Best with Satkunanathan to includes wide variety of system memory.

11. With respect to claim 7, Satkunanathan teaches that the electronic device is an optical disk drive, (an optical disk drive, par. [0092]). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Best with Satkunanathan to include and support more variety of storage medium.

12. With respect to claim 8, Satkunanathan teaches that the electronic device is a hard drive (hard drive, par. [0058]). It would have been obvious at the time the invention

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was made to a person having ordinary skill in the art to modify Best with Satkunanathan to include and support more variety of storage medium.

13. With respect to claim 9, Satkunanathan teaches that the electronic device is a computer and the executable firmware code is code in a basic input output system (BIOS) of the computer (the basic input/output system (BIOS), par. [0091]). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Best with Satkunanathan to identify and initialize firmware when the computer powered on.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHROUZ YOUSEFI whose telephone number is (571) 270-3558. The examiner can normally be reached on Monday-Thursday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

/S. Y./
Examiner, Art Unit 2132

/Gilberto Barron Jr/
Supervisory Patent Examiner, Art Unit 2132